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10/20/2005

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EXAMINER

SHIBRU, HELEN

ART UNIT

PAPER NUMBER

2616

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/744,112	Applicant(s) LEWIS ET AL.	
	Examiner HELEN SHIBRU	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 6 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 6, 7 and 13 is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-12 and 14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Response to Amendment

1. The amendments, filed 08/05/2005, have been entered and made of record. In view of the Applicants' amendments to the title, the specification and the drawings, the objection to the title, the specification, and the drawings are hereby withdrawn.

Response to Arguments

2. Applicant's arguments filed 08/05/2005 have been fully considered but they are not persuasive.

In re page 9, Applicant states "Nowhere does Hickey teach or suggest the feature of providing to the user the opportunity to select another one of the playback modes without interrupting playback of a current sequence of data units, and changing the playback sequence in response to the user selection of a new playmode." In re page 10, Applicant states "the Official Notice fails to cure the defect of Hickey as applied to claims 1 and 9".

In response, the Examiner respectfully disagrees. Hickey teaches that the system is in play mode before the selection options of R/S/P is displayed as shown in fig. 6a. While the system is in playmode, the user can select one of this modes, or/and the system is in a default mode (sequential) when one of the other modes are selected. The user can select the tracks with no priority in order to play it as a default mode (sequential) which will play after all the tracks with priority has been played.

It is respectfully submitted that the A-V PLAY/RECORD taught in Hickey performs the same functions as of the instant application.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4, 8-11, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hickey (U.S. Pat. No.5475835).

Regarding claim 1, Hickey discloses a method for controlling a system for processing a plurality of data units stored on a storage medium (see col. 9 lines 30-38), the system adapted to process a sequence of the data units (see col. 11 lines 20-35) in accordance with one of a plurality of playmodes (PMs) comprising standard (sequential), random (random) and programmed (programmed) playmodes (see fig. 6a row 2, R/S/P, and col. 17 lines 65-67), the method comprising the steps of:

A) playing back a sequence of data units according to one of the plurality of playmodes during a PLAY mode of operation (see col. 17 lines 12-22),

(B) providing to a user, during the PLAY mode of operation, an opportunity to select another one of the plurality of playmodes, the plurality of playmodes including a standard playmode representing a default sequence, a random playmode representing a random sequence and programmed playmode representing a sequence specified by a user, without interrupting playback of a current sequence of data units (see col. 16 line 36- col. 17 line 2, col. 17 lines 12-22, and 65-67, and col. 18 lines 1-25, and see fig. 6, and fig. 6a MODE R/S/P), and

C) in response to user selection of a new playmode, changing the playback sequence of the data units in accordance with the newly selected playmode (see col. 17 lines 65-67 and col. 18 lines 1-3, the mode which is chosen will turn green).

Regarding claim 2, Hickey teaches the limitation in (B) comprises the step of generating an on-screen display overlaid onto a video display (see col. 10 lines 30-40) which allows the user to select one of the plurality of playmodes while continuing to watch the playback of the data units in a background portion of the video display (see col. 16 lines 36-67, col. 17 lines 1-2, col. 17 lines 12-22, and fig. 6 and fig. 6a).

Regarding claims 3 Hickey teaches step (B) is preceded by the step of determining whether a mode of operation enabling selection of one of the plurality of playmodes during the PLAY mode of operation is enabled (see col. 16 lines 62-67 and col. 17 lines 1-2 after selecting the PLAY option in fig. 6, fig.6a will be shown); and performing steps (B) and (C) only if the mode of operation enabling modification of the plurality of playmodes during the PLAY mode of operation is enabled (see col. 17 lines 12-18, lines 65-67).

Regarding claim 4, Hickey teaches that the step of determining whether user modification of a playmode is enabled (see col. 17 lines 12-22, 65-67) is preceded by the step of determining whether the system is in the PLAY mode of operation (see col. 16 line 62- col. 17 line 2).

Regarding claim 8, Hickey, teaches step (C) is preceded by the step of allowing the user to select whether the newly selected playmode will be effective for all future playbacks or only the current playback (see col. 18 lines 63-67 and col. 19 lines 1-18).

Regarding claim 9, Hickey teaches an apparatus for processing data units stored on a storage medium according to to a particular playback sequence (see col. 9 lines 28-47 and col. 11 lines 20-35), the apparatus comprising:

playback circuitry (see fig. 1 it is inherent that the computer (13) shown in fig. 1 includes a playback circuitry to playback data stored in a recording medium) for accessing and processing data units stored on the storage medium during a PLAY mode of operation (see col. 9 lines 28-37); a user control device (touch pad and graphic display (14)) for receiving user input (see col. 9 lines 63-66, col. 10 lines 30-67, col. 11 lines 1-19, and col. 12 lines 55-65); a control unit, (see fig. 1 audio-visual control computer) coupled to the playback circuitry and the user control device, for conditioning the playback circuitry to activate the PLAY mode of operation and process the data units in a particular playback sequence in response to user selection of one of a plurality of playmodes (see col. 16 lines 36-67 and col. 17 lines 12-22),

the control unit provides to a user(col. 10 lines 30-67) during the PLAY mode of operation an opportunity to select from among the plurality of playmodes, the plurality of playmodes including a standard playmode representing a default sequence, a random playmode representing a random sequence and programmed playmode representing a sequence specified by a user, without interrupting the PLAY mode of the playback circuitry, and, in response to user selection of a new playmode, changing the playback sequence of the data units in accordance with the newly selected playmode (see col. 16 line 36-col. 17 line 2, col. 17 lines 12-22, and 65-67, and col. 18 lines 1-25, and see fig. 6, and fig. 6a MODE R/S/P).

Regarding claim 10, Hickey teaches comprising an on-screen display control coupled to the control unit, (see fig. 1 audio-visual control computer (13) and graphic display (14)) the on-screen display control providing a menu representing the plurality of playmodes allowing the user to select one of the plurality of playmodes while watching a playback of a current sequence of data

units in a background portion of the video display (see col. 12 lines 8-13, col. 16 lines 36-67, col. 17 lines 1-2, col. 17 lines 12-22, and fig. 6 and fig. 6a).

Regarding claim 11, Hickey teaches the control unit determines whether a mode of operation enabling selection of one of the plurality of playmodes during the PLAY mode of operation is enabled (see col. 17 line 67-col. 18 lines 1-3); and provides an opportunity to select a new playmode without interrupting the PLAY mode only if the mode of operation enabling modification of the plurality of playmodes during the PLAY mode of operation is enabled (see col. 16 lines 62-67 and col. 17 lines 1-2 after selecting the PLAY option in fig. 6, fig. 6a will be shown, col. 17 lines 12-18, lines 65-67, and col. 18 lines 1-3).

Regarding claim 14, Hickey teaches the control unit provides an on-screen display to allow the user to select whether the newly selected playmode will be effective for all future playbacks or only the current playback (see col. 18 lines 63-67 and col. 19 lines 1-18).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hickey.

Regarding claims 5 and 12, although Hickey does not specifically disclose the system comprises a DVD player and the storage medium comprises a DVD disk; the DVD disk includes a plurality of chapters; and the plurality of playmodes represent respectively different sequences of

chapters, Hickey does disclose a multiple record/play back units including a video disc record or playback (see col. 9 lines 29-47). Hickey further discloses the CD includes a plurality of chapters (see fig. 6a CD# AND Track #). Official notice is taken that the use of DVD (digital versatile disc) type media is well known in the art to store more audio, video, or other data. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify Hickey by utilizing the DVD to take advantage of the higher storage data capacity.

Allowable Subject Matter

7. Claims 6, 7 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 6 and 13, the Prior Art fails to teach or suggest the method and apparatus of claims 1 and 9 including determining the maximum number of the plurality of playmodes which may be performed with the storage medium; determining which of the number of the maximum number of the plurality of playmodes are actually possible with the storage medium; generating an on-screen menu displaying the maximum number of the plurality of playmodes, and which of the maximum number of the plurality of playmodes are actually possible.

Regarding claim 7, claim 7 is objected as being dependent upon the objected claim 6.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHIBRU HELEN whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, James Groody can be reached on (571) 272 7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Helen Shibru

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October 13, 2005



James J. Groody
Supervisory Patent Examiner
Art Unit 262-2616